

Hogenkamp *et al.*
Appl. No.: 09/814,123

Remarks

The Examiner has required restriction to one of six groups of inventions, Groups I-VI, under 35 U.S.C. § 121. Group I, represented by claims 1-14 and 17, is drawn to a compound and composition of Formula I. Group II, represented by claims 1, 15-17 and 24, is drawn to a compound and composition of Formula I. Group III, represented by claims 18-21 and 27, is drawn to a method of treating a disorder. Group IV, represented by claims 22-23, is drawn to a compound of Formula I. Group V, represented by claim 25, is drawn to a compound of Formula I. Group VI, represented by claim 26, is drawn to a compound of Formula I. The Examiner has also requested an election of a single disclosed species under 35 C.F.R. § 121.

Applicants hereby provisionally elect to prosecute the invention of Group I (claims 1-14 and 17) which is drawn to compounds of Formula I. This election is made without prejudice to or disclaimer of the other claims or inventions disclosed.

In addition, Applicants provisionally elect the species 1-(4-phenoxyphenyl)-1H-pyrazole-3-carboxamide, prepared in Example 2, at paragraphs [0128] and [0129] of the specification as originally filed. Claims 1-11 and 15-25 read on this species.

Both elections are made with traverse.

M.P.E.P. § 803 (Eighth Edition, August 2001), at page 800-4, left hand column, states as one of the criteria for a proper requirement for restriction that: "There must be a serious burden on the examiner if restriction is required ...". Thus, the Patent Office encourages the search and examination of an entire application on the merits, where such

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search and examination can be made *without* serious burden. Further, different classification or separate commercial data base and automated patent system (text) searches are not a proper standard for restriction requirement.

In the present case, Applicants respectfully assert that the search of restriction Groups I-VI does not impose a serious burden upon the Examiner, as a search concerning the patentability of the invention of one group will clearly uncover art of interest to the other groups. At least, the search of restriction Groups I, II, and IV does not impose a serious burden to the Examiner, since the invention of Group I is generic to inventions of Groups II and IV. Search required for Groups II and IV is required for Group I. Further, Applicants submit that the search of Group I and Group VI in part, as far Group VI includes compounds of Group I that are ³H or ¹⁴C radiolabeled, would not present an undue burden to the U.S.P.T.O.

Further, restriction practice is not applicable to a single claim. See *In re Weber*, 198 U.S.P.Q. 332 (C.C.P.A. 1978) and its companion case, *In re Haas*, 198 U.S.P.Q. 334 (C.C.P.A. 1978). These cases make it clear that 35 U.S.C. § 121 does not grant to the U.S. Patent and Trademark Office (PTO) the authority to refuse to examine a single claimed invention. Section 121 only applies to *plural* claimed inventions in *different* claims, wherein the different claims vary not just in scope, but in the invention to which each is directed.

Thus, Applicants submit that in the present case, restriction to one of six groups of inventions, as required by the Examiner, is improper. Therefore, the claims of Groups I-VI should be examined together. Applicants respectfully request that at least the claims of

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Groups I, II, IV, and VI (in part as far Group VI includes compounds of Group I that are ³H or ¹⁴C radiolabeled) be examined together.

Reconsideration and withdrawal of the Restriction Requirement, and consideration and allowance of all pending claims, are respectfully requested

Respectfully submitted,

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Date: July 31, 2002

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Applicants: Hogenkamp *et al.*

Due Date: August 1, 2002

Art Unit: 1626

Examiner: Shameem, G.

Application No.: 09/814,123

Docket: 1861.1270001

Filed: March 22, 2001

Atty: JMC/THN

For: Aryl Substituted Pyrazoles, Triazoles and Tetrazoles, and the Use Thereof

When receipt stamp is placed hereon, the USPTO acknowledges receipt of the following documents:

1. SKGF Cover Letter;

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1. SKGF Cover Letter;
2. Reply to Restriction and Election of Species Requirements; and
3. One (1) return postcard.



July 31, 2002

Please Date Stamp And Return To Our Courier



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July 31, 2002

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Commissioner for Patents
Washington, D.C. 20231

Group Art Unit 1626

Re: U.S. Patent Application

Appl. No. 09/814,123; Filed: March 22, 2001

**For: Aryl Substituted Pyrazoles, Triazoles and Tetrazoles, and the Use
Thereof**

Inventors: Hogenkamp *et al.*

Our Ref: 1861.1270001/JMC/THN

Sir:

Transmitted herewith for appropriate action are the following documents:

1. Reply to Restriction and Election of Species Requirements; and
2. One (1) return postcard.

It is respectfully requested that the attached postcard be stamped with the date of filing of these documents, and that it be returned to our courier. In the event that extensions of time are necessary to prevent abandonment of this patent application, then such extensions of time are hereby petitioned.

Commissioner for Patents
July 31, 2002
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The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency,
or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

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Enclosures

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